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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91179897
Party	Plaintiff Information Builders, Inc.
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

INFORMATION BUILDERS, INC.	:	
Opposer,	:	
v.	:	Opposition No. 91179897
BRISTOL TECHNOLOGIES, INC.	:	
Applicant.	:	

REPLY IN MOTION TO EXTEND
OPPOSER'S TESTIMONY PERIOD

I. INTRODUCTION

In response to this motion, Applicant has submitted a "Declaration" which is unsworn and does not meet the requirements of Rule 2.20, along with a brief which merely contains argument. Accordingly, it is believed that Opposer's motion should be treated as uncontested. To the extent that Applicant's submission is given consideration, nothing therein contradicts the facts set forth in the supporting declaration of Opposer's attorney.

This motion to extend the time for Opposer's testimony was filed before the expiration of the testimony period and is, therefore, timely. In order to receive favorable consideration, Opposer must show good cause for the

extension. American Vitamin Products, Inc. v. DowBrands Inc., 22 USPQ2d 1313 (TTAB 1992) citing Fed. R. Civ. P. 6(b).

> Ordinarily, the Board is liberal in granting extensions of time before the period to act has elapsed, so long as the moving party has not been guilty of negligence or bad faith and the privilege of extensions is not abused.
>
> American Vitamin at 1315

II. OPPOSER HAS GOOD CAUSE FOR BRINGING THE MOTION

TBMP 509.01(a) admonishes that

> A motion to extend must set forth with particularity the facts said to constitute good cause for the requested extension; mere conclusory allegations lacking in factual detail are not sufficient.

It is undisputed that after Opposer's attorney suggested the opening of settlement talks between the parties, Applicant's attorney agreed to take the matter up with his client and reply to Opposer's attorney. Declaration of Howard F. Mandelbaum, ¶ 5.

It is also undisputed that Applicant's attorney solicited from Opposer's attorney a proposal for settling the opposition for communication to his client. Declaration of Howard F. Mandelbaum, ¶ 6.

It is further undisputed that Applicant's attorney undertook to obtain information necessary to formulate an

amended identification of Applicant's goods to which the parties might agree as a way to settle the dispute. Declaration of Howard F. Mandelbaum, ¶ 7.

Moreover, it is undisputed that Applicant's attorney told Opposer's attorney that there might be some delay before responses could be obtained from Applicant. Declaration of Roger Belfay, ¶ 6. Accordingly, Opposer's attorney waited patiently and did not press Applicant's attorney for a quick response.

In hindsight, it certainly would have been preferable for Opposer's attorney to have obtained Applicant's attorney's consent to an extension before waiting for his anticipated responses. Opposer's attorney may have been mistaken in assuming that such a consent would be forthcoming when needed. However, it is respectfully submitted that Opposer's mistaken assumption did not amount to negligence. Under the cordial atmosphere in which the attorneys for the parties discussed settlement, the anticipated courtesy of mutual consents to an extension in furtherance of settlement is not believed to have been unreasonable.

Having deferred the preparation of testimony and filing of evidence while believing there was a substantial possibility of settling the opposition, and then learning

for the first time, four days before the close of Opposer's testimony period, that settlement would not be possible, Opposer is seeking a reasonable extension of the testimony period in order to place it in the same position as it would have been if Applicant had not undertaken to pursue settlement and, most importantly, to avoid entry of judgment against Opposer for failure to take testimony and/or submit evidence.

A 30 day extension will not prejudice Applicant in any way and Applicant has asserted no claim to the contrary. A denial of Opposer's motion will result in a judgment in favor of Applicant without consideration of the merits.

In opposing Opposer's motion, Applicant relies upon two cases cited in footnote 141 to TBMP 509.01(a).

Instruments SA Inc. v. ASI Instruments Inc., 53 USPQ2d 1925, 1927 (TTAB 1999) was cited in the TBMP for the proposition that "cursory or conclusory allegations that were denied unequivocally by the nonmovant and were not otherwise supported by the record did not constitute a showing of good cause". In the present case, the specific facts set forth in the declaration of Opposer's attorney are not in dispute.

Moreover, ASI was a case where the Applicant had consented to an extension of the testimony period. The

Board denied a motion to extend discovery based on four findings, none of which is applicable here.

First the Board found no indication that the Applicant would seriously consider Opposer's settlement offer. Here it has been established that that Applicant's attorney agreed to approach his client with a proposal for direct talks between the parties and then requested a settlement offer from Opposer to be communicated through the attorneys. In addition, Applicant's attorney undertook to obtain information about Applicant's products from which an amendment to Applicant's identification of goods could be prepared as a basis for settlement. Clearly Applicant's attorney appeared to be seriously considering settlement.

Second, the Applicants in ASI rejected as untrue the Opposer's allegations regarding settlement. Here Opposer's allegations regarding settlement have not been contradicted and have, to the contrary, been confirmed in part by Applicant's attorney. Declaration of Roger Belfay, ¶ 6.

Third, the Board found that the ASI Opposer should have known that settlement or serious talk of settlement was unlikely. Opposer in the present case had no reason to believe that settlement could not be achieved or that serious settlement talks could not be conducted until so

informed by Applicant's attorney four days before the close of Opposer's testimony period.

Fourth and last, the Board in ASI found that the Opposer had squandered some 2 1/2 months without conducting the discovery for which it was requesting an extension of time. Such is not the case here.

From the above it is seen that ASI is inapplicable to the facts of the present case.

Fairline Boats PLC v. New Howmar Boats Corp., 59 USPQ 1479 (TTAB 2000) is cited in the TBMP footnote for the denial of a motion for an extension where the moving party ". . . demonstrated no expectation that proceedings would not move forward during any such negotiations."

In the present case, it is undisputed that Opposer's attorney telephoned Applicant's attorney to request his availability on dates for testimony. Before any specific times and places were mentioned, the discussion shifted to settlement. In view of the understanding that settlement would be pursued, the discussion never returned to the designation of specific dates and places for testimony. It may reasonably be inferred that the shift to settlement talks resulted in an expectation that testimony would not proceed as originally contemplated.

III. OPPOSER HAS NOT BEEN GUILTY OF NEGLIGENCE OR BAD FAITH

Opposer's sole motivation for delaying the taking of testimony in two remote states, New York and Minnesota, within the original testimony period was to avoid unnecessary expenditure of time and money if efforts to reach a settlement succeeded. The undisputed facts show that settlement was being pursued by both of the parties in cooperation and was not a unilateral proposal.

IV. OPPOSER HAS NOT ABUSED THE PRIVILEGE OF EXTENSIONS

This is the first time that Opposer has requested an extension of any time period since the commencement of the opposition. Opposer has diligently prosecuted this opposition by taking discovery, obtaining leave to amend its complaint and moving for summary judgment upon learning that Applicant misstated its use of the opposed mark in its original application, and following up with further discovery in the interim between the lifting of a suspension by the Board and the opening of testimony.

Any delay in bringing this opposition to trial cannot be blamed on Opposer. Applicant was granted leave to amend its basis to intent to use after its allegation of use was found to be untrue. Applicant was granted further time to file a declaration of intent to use after it failed to do

so in its motion for leave to change basis. Applicant was also granted leave to extend it's time to file an answer to the amended complaint after being found by the Board to be in default for failing to so before the expiration of the deadline.

V. CONCLUSION

From the above it is seen that Opposer's motion to extend testimony is made for good cause, in good faith and without negligence, and does not amount to an abuse of the privilege of extensions. Accordingly, favorable consideration of Opposer's motion for an extension is respectfully requested.

Respectfully submitted,

Dated: October 6, 2009
White Plains, NY

/Howard F. Mandelbaum/
Howard F. Mandelbaum

CERTIFICATE OF SERVICE

It is hereby certified that a copy of the foregoing Reply in Motion to Extend Opposer's Testimony Period has been forwarded, this October 6, 2009 by first class mail to:

Roger L. Belfay, Esq.
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/Howard F. Mandelbaum/
Howard F. Mandelbaum